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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,456	02/22/2002	Woo Je-Suk	2051	8405

7590 11/17/2003
Striker, Striker & Stenby
103 East Neck Road
Huntington, NY 11743

EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/17/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

CLOO

Office Action Summary	Application No. 10/080,456	Applicant(s) JE-SUK ET AL.	
	Examiner Patricia L. Nordmyer	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Withdrawn Rejections

1. The 35 U.S.C. 102 rejection of claims 1 – 5 as anticipated by Meroni in Paper #6, Page 3, Paragraph #5 is withdrawn due to Applicant's amendment in Paper #7.
2. The 35 U.S.C. 103 rejection of claims 6 – 8 over Meroni in view of Dong in Paper #6, Page 3, Paragraph #5 is withdrawn due to Applicant's amendment in Paper #7.

New Rejections

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 – 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meroni in view of Pitts (USPN 4,415,946).

Meroni discloses a single layer polyvinyl chloride base (Column 3, lines 58 – 59) containing a high density of perforations (Figure 2, #1) formed from latticework (Column 3, lines 32 – 33) in a floor covering (Column 1, lines 6 – 7). Bonded to one side of the base is a textile covering (Column 3, lines 25 – 27 and Figure 2, #2) made from a textile woven material

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(Column 3, lines 62 – 64). However, Meroni fails to disclose the perforated high density sheet consisting of two to twenty high density sheets joined together with heat, where the holes of the first sheet are not aligned with the holes of the adjoining polyvinyl chloride sheets, and wherein the holes of the first sheet are in communication with the holes of the adjoining polyvinyl chloride sheets.

Pitts teaches two layers of polyvinyl chloride with perforations that are aligned with one another (Figure 2, #13, 11 and 16 and Column 2, lines 37 – 39, 51, and 65 – 67) in a floor covering that has a conventional surface (Column 1, line 66 to Column 2, line 2) while having a chair mat that contains anti-static properties through the use of semi-conductive layers and materials.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the two layers of polyvinyl chloride containing apertures in Meroni in order to have a floor covering that has a conventional surface while having a chair mat that contains anti-static properties through the use of semi-conductive layers and materials as taught by Pitts.

Regarding the limitation of the layers of polyvinyl chloride being joined together by heat in claims 3 – 5, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even

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though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the alignment of the holes so that they are off set from one another. One skilled in the art would have been motivated to do so in order to change how the bottom surface of the mat looks.

5. Claims 6 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meroni in view of Pitts as applied to claims 1 - 5 above, and further in view of Dong.

Meroni discloses the claimed floor covering formed with a perforated polyvinyl chloride except for a glass fiber sheet being attached to the upper or lower side of the perforated sheet, the glass fiber sheet being attached to both the upper and lower sides of the perforated sheet and the covering attached to the perforated sheet being selected from non-woven fabric, polyvinyl chloride sheet, rubber sheet and foamed synthetic resin sheet.

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Dong teaches a non-woven glass fiber mat (Figure 1 and Column 8, line 15) used in flooring (Column 1, lines 14 – 16) for the purpose of forming glass fiber mats with a wide range of properties including high porosity to help with the drainage of water away from the surface.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the glass fiber mat in Meroni in order to have a glass mat that has high porosity to help with the drainage of water away from the surface of the floor mat as taught by Dong.

Meroni, as modified with Dong, discloses the claimed invention except for the glass fiber sheet being attached to both the upper and lower sides of the perforated sheet. It would have been obvious to one having ordinary skill in the art at the time the invention was made to place a glass fiber sheet on both sides of the floor mat in order to give the floor reinforcement and strength to withstand wear and tear, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Response to Arguments

6. Applicant's arguments with respect to claims 1 – 8 have been considered but are moot in view of the new ground(s) of rejection. However, some of the arguments regarding the claims will be responded to below.

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In response to applicant's argument that the floor covering of the present invention removes shrinkage and expansion differences between the perforated high density PVC sheet and the surface material, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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pln


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

4/1/03